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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,644	06/15/2005	Uwe Hannsmann	DE920020028US1	8626
47069 7590 07/23/2008 KONRAD RAYNES & VICTOR, LLP ATTN: IBM54 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212				
EXAMINER				
CHEMPAKASERIL, ANN J				
ART UNIT		PAPER NUMBER		
2166				
MAIL DATE		DELIVERY MODE		
07/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,644

Applicant(s)

HANNSMANN ET AL.

Examiner

ANN J. CHEMPAKASERIL

Art Unit

2166

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 16, 17, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 16, 17, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 16-17, 39-40 are pending

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 5, 2008 has been entered.

Response to Arguments

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are regarding amended claims which will be addressed in the rejection below

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 17 states "receiving a request to renew the license from the client and make payment for the renewal in response to the client determining that the updated license status indicates that the license has expired. Claim 1 requires license status update after usage occurring before synchronization. Therefore after renewal the client usage is not tracked and the license status is not updated. Applicant does not have support for not tracking usage after synchronization.

Claim 39 says "the amount of usage at the client after license is expired. Claim 1 says "license status is updated based on client usage" Applicant's disclosure states that usage after expiration does not change license status. There is no support for usage at the client after license is expired.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 16-17, 39-40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it states "the license information indicates a license status" in line 5, "local license related data on the client indicating an updated license status" in line 8, and "the updated license status in the local license related data." in line 10-11. It is unclear to the examiner the local license related data indicates an updated license

status, when the license information indicates a license status, and then the local license related data, then contains an updated license status. Are these three limitations related or are they different entities that indicate different status information.

As per claim 17, it states "synchronizing of local license related data" It is unclear to the examiner if this different from "synchronizing with local license related data as stated in claim 1, line 7

Claim 39 says "the amount of usage at the client after license is expired. Claim 1 says "license status is updated based on client usage" Applicant's disclosure states that usage after expiration does not change license status. It is unclear whether usage is tracked after license is expired.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 10, 16-17, 19-21, 28-31, and 39-44 rejected under 35 U.S.C. 102(e)

as being anticipated by US Patent Application 2003/0088516 issued to Remer et al.
further in view of US Patent 7203966 issued to Aburri et al. (hereinafter Aburri)

As per claims 1, 10, and 28, Remer discloses a method for providing of content data to a client (move logic and data over networks to the end user or point- of service (POS) computer [0033]), comprising:

receiving of a selection of content data from the client (selection of licenses are requested by POS that access data [0033]) ;

generating a file comprising license information and a locator for the content data, wherein the license information indicates a license status enabling the client to access the content data (The service agent first verifies that the digital signature of the retrieved POS license is valid (310). If so, the service agent compares the Node ID field of the current POS license with the Node ID of the existing license in the discovery database (330). If the Node IDs are different, then this must be a new POS license that has not yet been collected to the discovery database. The service agent collects a copy of the new POS license into the Servicing component's discovery database (340).

[0077]);

sending of the file to the client (sending the file with license and id to POS [0079]);

Remer does not appear to explicitly disclose synchronizing with local license related data on the client indicating an updated license status based on an amount of client usage of the content data following the sending of the file to the client and before synchronizing

However Aburri discloses synchronizing with local license related data on the client indicating an updated license status based on an amount of client usage of the

content data, wherein the license status is updated at the client, and wherein the client usage that results in the updated license status in the local license related data occurs at the client following the sending of the file to the client and before synchronizing (corresponding to licenses 16 presently or formerly in the license store 38. Such state information is created by the DRM system 32 and stored in the state store 40 as necessary. For example, if a particular license 16 only allows a predetermined number of renderings of a piece of corresponding digital content 12, the state store 40 maintains state information on how many renderings have in fact taken place in connection with such license 16 [Col 17, lines 55-69])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms.. [Col 3, lines 35-50])

As per claim 2, Remer discloses in response to receiving the selection of the content data from the client, requesting of license conditions information from a license server (license conditions can be retrieved from servicing agent for the POS [0031]) ;

sending of information indicative of one or more license offers to the client (The current POS license, whether it be an install, trial, or previously purchased license, is collected by the external license servicing agent to a discovery database that resides on the service management console [0035]);

and receiving an acceptance from the client (an electronic commerce site that will issue purchased licenses for the software services installed on the POS computers (240). By purchasing, the client accepts the license offers.)

As per claim 16, Remer discloses the generated file comprises an XML file having a defined DTD format (The exchange of licenses may be accomplished in a number of ways. In one example implementation of the method, the exchange is accomplished by formatting an exchange license file that is in well-formed, non-validated XML described by the following DTD [0087]).

As per claim 17, Remer discloses synchronizing of local license related data on the client further comprises: receiving a request to renew the license from the client and make payment for the renewal in response to the client determining that the updated license status indicates that the license has expired (refreshing. In another implementation, the licensing service agent may need to periodically collect copies of the POS licenses (either new install or trial licenses, or expired purchased licenses) from one or more POS computers and exchange them in bulk for new purchased licenses. [0021] The service agent maintains copies of collected POS licenses and new purchased licenses issued by the third party in a discovery database. The service agent synchronizes the collection of licenses from POS as well as the replacement of the POS licenses with new licenses using the discovery database. [0023])

As per claim 39, Remer discloses the amount of usage of the content data but does not explicitly disclose the amount of usage of the content data comprises the amount of usage at the client after the license status is expired at client

Aburri discloses the claimed the amount of usage of the content data comprises the amount of usage at the client after the license status is expired at client (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms.. [Col 3, lines 35-50])

As per claim 40, Cheng discloses during synchronization, determining the amount of usage of the content data at the client after the license status is expired at client (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64]);

Receiving payment for the amount of usage of the content data after the license status is expired, wherein the synchronizing with the local license related data comprises renewing the local license related data to allowed continued use of the content data in response to receiving the payment for the amount of usage (copy/replacement license may also expire, however, if a user does not connect and synchronize with the license synchronization server from a device before the expiry date of the copy/replacement license. [Col 63-Col 64])

Art Unit: 2162

Remer and Aburri are analogous art because they are from the same field of endeavor of providing data to clients

It would have been obvious to modify the invention Remer to include the feature of Aburri. Modification allows the user to render the digital content according to the rights conferred by the license and specified in the license terms.. [Col 3, lines 35-50])

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann J Chempakaseril/
Examiner, Art Unit 2166
July 18, 2008

/Shahid Al Alam/
Primary Examiner, Art Unit 2162